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EXAMINER

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1794

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/652,860	Applicant(s) TOMCZYK, JOHN	
	Examiner Christopher P. Bruenjes	Art Unit 1794	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 August 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12, 14-39, 41-69, 81-88 and 90-94 is/are pending in the application.
- 4a) Of the above claim(s) 1-12, 14-18, 27-39, 41-46 and 83-88 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 19-26, 47-69, 81, 82 and 90-94 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

WITHDRAWN REJECTIONS

1. The 35 U.S.C. 112 rejections of claims 23-24, 51-52, 54-56, and 62-69 of record in the Office Action mailed April 17, 2007, Pages 5-6 Paragraph 8, have been withdrawn due to Applicant's amendments in the Paper filed August 21, 2007.

Double Patenting

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 19-26, 47-56 and 65-69 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-37 of U.S. Patent No. 7,153,555.

Although the conflicting claims are not identical, they are not patentably distinct from each other because the limitations of claims 19-26, 47-56, and 65-69 are all taught by the claims in Patent

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'555 except for the following differences, which are all obvious changes. First, Patent '555 does not specify that the textured or roughened layer is unitary, however Patent '555 refers to the lenticular lens material as one layer and lenticular lenses are textured. Second, Patent '555 contains an additional transparent layer between the textured layer and the ink layer, but applicant's claims are open and other layers can be present. Although applicant's claims state that the ink layer is bonded to the second surface, bonded does not require that the layers be in direct contact they can be bonded via another layer and still read on the limitation. Third, Patent '555 does not teach that the seam can be a zig-zag seam or sinusoidal seam, but these are obvious shape changes for aesthetic appeal.

4. Claims 19-26, 47-69, and 81-82 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 19-26, 47-69, and 81-82 of copending Application No. 10/472,054. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims in application '054 are almost identical to applicant's claims except that the claims in application '054 require a lenticular lens layer in place of the textured or roughened layer of applicant's claims. However, a lenticular lens is a textured layer.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 90-94 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The surface comprising a “texture selected from football texture and a basketball texture” renders the claims vague and indefinite because footballs and basketballs and many different textures and appearances. Also new footballs and basketballs are developed having textures that have never been used previously. Therefore, basing the surface texture on a comparison to other objects that are known to have varied textures and constantly being redesigned renders the claimed surface vague and indefinite.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

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8. Claims 19-26, 47-54, and 65-69 are rejected under 35 U.S.C. 102(b) as being anticipated by Guest (US 2002/0114080 A1).

The effective filing date of Applicant's invention is the filing date of this application. Applicant's invention does not get the benefit of the dates of the earlier PCT application and provisional applications because the PCT application that this application is a continuation-in-part of does not provide 35 U.S.C. 112 first paragraph support for the claims. Specifically, the claims of the child application are broader than the disclosure of the parent application and although a lenticular lens layer would inherently have a textured surface lenticular lens layer itself does not provide written description for any other types of textured surfaces so therefore does not provide written description for the broad recitation of textured or roughened surface. See MPEP 2163.

Regarding claims 19, 47, and 65, Guest anticipates a product for displaying images created with textured or roughened material such as optical ridges (p.4, paragraph 4 and reference number 22, Figure 2). The optical ridges are non-lenticular because they do not form convex lenses as shown by the figures. Furthermore, although the insert contains lenticular lens material the optical ridges from the first surface of the insert is not lenticular and is specifically differentiated from the lenticular lens material layer (reference number 24, Figure 2). The product comprises a plastic display surface (reference number 12, Figure 2 and p.3, paragraphs 21-22) and a closed surface textured or roughened insert (reference number 20, Figure 2) in abutting contact with the display surface. The insert includes a unitary textured or roughened layer (reference number 22, Figure 2) having a first surface (the top surface of reference number 22 in Figure 2) and a second surface (the bottom surface of reference number 22 in Figure 2).

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The insert further comprises first and second ends for contact to one another to form a seam, and first and second edges between the first and second ends (p.5, paragraph 39). An ink layer (reference number 28, Figure 2) is bonded to the second surface of the textured or roughened layer, and a bonding and thermal protection substrate (reference number 30, Figure 2) is attached to and covering the ink layer. The product further comprises a means for retaining the insert in the abutting contact position on the display surface by bonding to the display surface.

Regarding claims 20, 48, and 66, the retaining means comprises a bonding interface between the substrate and material of the plastic display surface (p.7, paragraph 51).

Regarding claims 21, 49, and 67, the substrate comprises a material selected from the group consisting of polypropylene, polyester, polyvinyl chloride, polycarbonate, and APET (p.8, paragraph 57) and UV-curable coatings (p.7, paragraph 46).

Regarding claims 22, 50, and 68, the substrate has a thickness in the range of 0.0127 to 0.0762 millimeters, which are 0.5 to 3 mils (p.7, paragraph 50).

Regarding claims 23-24 and 51-52, the retaining means comprises frame members connected to the display surface and abuttingly contacting exposed edges of the insert, in which the frame members extend a predetermined retention distance onto the first surface adjacent each of the exposed edges (p.5, paragraph 37 and reference numbers 14, 16, and 18, Figure 3).

Regarding claims 25, 53, and 69, the product is a container and the display surface is an outer wall of the container (Figure 1). Furthermore, regarding claim 25, the textured or roughened surface comprises a random set or collection of features forming a lenticular lens. Note random set or collection of features is given its broadest reasonable interpretation, which includes a set that is selected at random.

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Regarding claim 26, the insert extends along substantially the entire perimeter of the outer wall such that two side edges of the insert form a seam (p.5, paragraph 39).

Regarding claim 54, the two side edges of the insert are beveled and overlap to form a straight seam (p.5, paragraph 39).

9. Claims 19-21, 23, 25-26, 47-49, 51, and 53 are rejected under 35 U.S.C. 102(b) as being anticipated by Goggins (WO 01/96079 A2).

The effective filing date of Applicant's invention is the filing date of this application. Applicant's invention does not get the benefit of the dates of the earlier PCT application and provisional applications because the PCT application that this application is a continuation-in-part of does not provide 35 U.S.C. 112 first paragraph support for the claims. Specifically, the claims of the child application are broader than the disclosure of the parent application and although a lenticular lens layer would inherently have a textured surface lenticular lens layer itself does not provide written description for any other types of textured surfaces so therefore does not provide written description for the broad recitation of textured or roughened surface. See MPEP 2163.

Regarding claims 19 and 47, Goggins anticipates a product for displaying images created with roughened material such as lenticular lens material (see abstract). Note giving the claims its broadest reasonable interpretation provides that the new limitation in the independent claims defines the first surface is being either non-lenticular textured or roughened. Therefore, a lenticular lens material still reads on the invention where the lenticular lens represents a roughened surface as opposed to a non-lenticular textured surface. The product comprises a

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plastic display surface (the molded plastic that fills the mold in Figures 6-8) and a closed surface roughened insert (reference number 10a, Figure 5) in abutting contact with the display surface. The insert includes a roughened layer (reference number 12, Figure 5) having a first surface (the outer surface of reference number 12 in Figure 5) and a second surface (the inner surface of reference number 12 in Figure 5). The insert further comprises first and second ends for contact to one another to form a seam, and first and second edges between the first and second ends (Figs. 12-13, p.13, l.5-9, and p.13, l.15-18). Goggins teaches a seam formed by the first and second opposed ends of the textured or roughened layer because in columns 7 and 8 Goggins teaches that the layer is formed from a flat piece that is shaped to cover a cup and that reference 70 of Figures 12 and 13 represents the shaped textured or roughened layer. Reference 70 is shown in Figures 12 and 13 to be wrapped completely around the cup to form a circular cross-section. Therefore, because the layer is formed from a flat piece it must have a seam to form a complete circle. An ink layer (reference number 14, Figure 5) is bonded to the second surface of the textured or roughened layer, and a bonding and thermal protection substrate (reference number 16, Figure 5) is attached to and covering the ink layer. The product further comprises a means for retaining the insert in the abutting contact position on the display surface by bonding to the display surface.

Regarding claims 20 and 48, the retaining means comprises a bonding interface between the substrate and material of the plastic display surface (p.9, l.17-24).

Regarding claims 21 and 49, the substrate comprises a material selected from the group consisting of vinyl plastic or opaque white ink (p.6, l.25 – p.7, l.2). Note an opaque white ink

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inherently either a solvent based coating or water-based coating since that covers these two groups of coatings includes all types of ink.

Regarding claims 23 and 51, the retaining means comprises frame members connected to the display surface and abuttingly contacting exposed edges of the insert since the insert is inserted into the mold during formation and in the embodiment in which the insert forms a portion of the outer surface of the cup such as a belly band (p.13, l.7-9) the container would form on both the top edge and bottom edge of the insert.

Regarding claims 25 and 53, the product is a container and the display surface is an outer wall of the container (Figure 10).

Regarding claim 26, the insert extends along substantially the entire perimeter of the outer wall such that two side edges of the insert form a seam (Figs. 12-13, p.13, l.5-9, and p.13, l.15-18). Note that the broadest reasonable interpretation of seam does not require that the edges forming the seam be in contact or abutting.

10. Claims 57-59 and 61-62 are rejected under 35 U.S.C. 102(b) as being anticipated by Goggins (WO 01/73497 A2).

The effective filing date of Applicant's invention is the filing date of this application. Applicant's invention does not get the benefit of the dates of the earlier PCT application and provisional applications because the PCT application that this application is a continuation-in-part of does not provide 35 U.S.C. 112 first paragraph support for the claims. Specifically, the claims of the child application are broader than the disclosure of the parent application and although a lenticular lens layer would inherently have a textured surface lenticular lens layer

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itself does not provide written description for any other types of textured surfaces so therefore does not provide written description for the broad recitation of textured or roughened surface.

See MPEP 2163.

Regarding claim 57, Goggins anticipates a product for displaying images created with roughened material (see abstract) comprising a paper display surface (reference number 22, Figure 8, p.12, l.23-25). The product further comprises a closed-surface roughened insert (reference number 30, Figure 6) maintained in position adjacent the paper display surface. Note giving the claims its broadest reasonable interpretation provides that the new limitation in the independent claims defines the first surface is being either non-lenticular textured or roughened. Therefore, a lenticular lens material still reads on the invention where the lenticular lens represents a roughened surface as opposed to a non-lenticular textured surface. The insert includes a roughened layer (reference number 28, Figure 8) having a first surface (the top surface of reference number 28, Figure 8) and a second surface (reference number 28a, Figure 8), and an ink layer (reference number 40, Figure 8) bonded to the second surface of the textured or roughened layer. The first surface of the insert comprises a random collection of features forming a lenticular lens. The insert further comprises a bonding and thermal protection substrate (reference number 42, Figure 8) attached to the ink layer.

Regarding claim 58, the sleeve is maintained in position adjacent the paper surface by an adhesive (reference number 44, Figure 8) between the substrate and the paper display surface.

Regarding claim 59, the substrate comprises material such as vinyl plastic or opaque, white ink, which is inherently a solvent-based coating or water-based coating since all inks fall into one of those categories.

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Regarding claim 61, the product is a container and the display surface is an outer wall of the container (Figure 6 and p.11, 1.12-24).

Regarding claim 62, the two side edges of the insert form a straight seam (Figure 6).

11. Claims 19-26, 47-54 and 65-69 are rejected under 35 U.S.C. 102(e) as being anticipated by Raymond et al (USPN 7,153,555).

The applied reference has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

Regarding claims 19, 47, and 65, Raymond et al anticipate a product for displaying images created with textured or roughened material such as optical ridges (p.4, paragraph 4 and reference number 22, Figure 2). The optical ridges are non-lenticular because they do not form convex lenses as shown by the figures. Furthermore, although the insert contains lenticular lens material the optical ridges of the first surface of the insert is not lenticular and is specifically differentiated from the lenticular lens material layer (reference number 24, Figure 2). The product comprises a plastic display surface and a closed surface textured or roughened material in abutting contact with the display surface. The insert includes a unitary lenticular lens layer having a first surface and a second surface having optical ridges forming the first surface. The insert further comprises first and second ends for contact to one another to form a seam, and first

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and second edges between the first and second ends. An ink layer is bonded to the second surface of the textured or roughened layer, and a bonding and thermal protection substrate is attached to and covering the ink layer. The product further comprises a means for retaining the insert in the abutting contact position on the display surface by bonding to the display surface. (Claim 1, col.18, 1.18-33).

Regarding claims 20, 48, and 66, the retaining means comprises a bonding interface between the substrate and material of the plastic display surface (claim 2, col.18, 1.34-36).

Regarding claims 21, 49, and 67, the substrate comprises a material selected from the group consisting of polypropylene, polyester, polyvinyl chloride, polycarbonate, and APET and UV-curable coatings (claim 3, col.18, 1.37-42).

Regarding claims 22, 50, and 68, the substrate has a thickness in the range of 0.0127 to 0.0762 millimeters, which are 0.5 to 3 mils (claim 4, col.18, 1.43-45).

Regarding claims 23-24 and 51-52, the retaining means comprises frame members connected to the display surface and abuttingly contacting exposed edges of the insert, in which the frame members extend a predetermined retention distance onto the first surface adjacent each of the exposed edges (claim 7, col.18, 1.55-56).

Regarding claims 25, 53, and 69, the product is a container and the display surface is an outer wall of the container (Figure 1).

Regarding claim 26, the insert extends along substantially the entire perimeter of the outer wall such that two side edges of the insert form a seam (col.9, 1.40-63).

Regarding claim 54, the two side edges of the insert are beveled and overlap to form a straight seam (col.9, 1.40-63).

12. Claims 19-26, 47-69, and 81-82 are rejected under 35 U.S.C. 102(e) as being anticipated by McCannel et al (US 2004/0095648 A1)

The applied reference has a common inventor with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

Claims 19-26, 47-69, and 81-82 of McCannel et al are the same as Applicant's claims 19-26, 47-69, and 81-82 except that McCannel teaches the outside layer is a lenticular lens layer and Applicant claims the outside layer as a textured or roughened layer. However, a lenticular lens layer is a roughened layer as shown by reference number 20 in Figure 2 of McCannel.

Therefore, because the lenticular lens layer of McCannel is a roughened layer and all of the other limitations are taught exactly the same in McCannel, Applicant's claims are anticipated. Note giving the claims its broadest reasonable interpretation provides that the new limitation in the independent claims defines the first surface is being either non-lenticular textured or roughened. Therefore, a lenticular lens material still reads on the invention where the lenticular lens represents a roughened surface as opposed to a non-lenticular textured surface.

Claim Rejections - 35 USC § 103

13. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

14. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

15. Claims 54-56, 81-82 and 90-94 are rejected under 35 U.S.C. 103(a) as being unpatentable over Goggins (USPN 6,635,196).

Regarding claims 54-56, Goggins teaches all that is claimed in claim 47 as shown above.

Goggins fails to teach the shape of the seam. However, it would have been obvious to one having ordinary skill in the art at the time Applicant's invention was made that any known shape for the seam would be used to form the seam including a straight seam, sinusoidal seam or zig-zag seam, depending on the intended end result and appearance of the finished article, absent the showing of unexpected result.

Therefore, it would have been obvious to one having ordinary skill in the art at the time Applicant's invention was made to select a straight seam, sinusoidal seam, or zig-zag seam for

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the implicit seam of Goggins depending on the intended end result and appearance of the finished article, absent the showing of unexpected result.

Regarding claims 81-82, Goggins teaches an integrally formed closed surface textured or roughened sleeve (reference number 10a) comprises a textured or roughened layer (reference number 12, Figure 2c) comprising a collection of features on an outer face of the layer and an inner face opposed to the collection of features. The sleeve further comprises an outer bonding layer (reference number 20, Figure 2c) having an outer face adjacent the inner face of the textured layer and an ink layer (reference number 14, Figure 2c) having an outer face adjacent the inner face of the outer bonding layer, and the size and features of the textured layer are coordinated with the image layer since the sleeve forms a lenticular lens material. The sleeve further comprises a paper core layer (reference number 22, Figure 2c and col.4, 1.55-60) having an outer face adjacent the inner face of the ink layer and an inner bonding layer having an outer face adjacent the inner face of the paper core for bonding the paper substrate to the molten plastic forming the container.

Goggins fails to teach the sleeve further comprising a clear core layer in the same embodiment as all of the other layers. However, Goggins teaches in an additional embodiment of Figure 2b that a clear core layer (reference number 16, Figure 2b) is added to the lenticular lens sleeve of Goggins between the textured layer and image layer in order to provide a special effect or enhance or provide contrast for the image (col.4, 1.25-45). One of ordinary skill in the art would have recognized that Figures 2b and 2c are used as examples to show the many different components that can be added to the sleeve of Goggins and therefore it would have been obvious to combine the components for particular purposes.

Therefore, it would have been obvious to one having ordinary skill in the art at the time Applicant's invention was made to add the clear core layer of the embodiment of Figure 2b to the embodiment of Figure 2c, in order to provide a special effect or enhance or provide contrast for the image, as taught by Goggins in the embodiment of Figure 2b.

Regarding claims 90-94, footballs and basketballs have a myriad of different surface textures. Therefore, as long as there is one football or basketball having the same texture as Goggins then the limitation is taught. Because there are a number of different surfaces textures it would have been obvious to one having ordinary skill in the art at the time Applicant's invention was made to form the texture in whatever texture desired for its intended purpose including textures that overlap with the many textures forming the surface of different footballs and basketballs.

16. Claims 55-56 and 90-94 are rejected under 35 U.S.C. 103(a) as being unpatentable over Guest (USPN 6,490,093).

Guest teaches all that is claimed in claim 47 and teaches that the two side edges of the insert form a straight seam having beveled overlapped edges, but fails to teach the seam is sinusoidal or zig-zag. However, Guest teaches that in addition to the straight seam taught in Figure 1, the side edges of the insert are formed from a large number of other interweaving shapes and mating techniques to obtain the beneficial features of the container, which is to overcome the weakness inherent in a butt joint between the side edges of the insert including a "zipper" like structure (col.9, 1.59 - col.10, 1.1-6). Therefore, it would have been obvious to one having ordinary skill in the art that any interweaving shape seams would be used to form the

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seam between the side edges of the insert in order to overcome the weakness of a butt joint, as taught by Guest.

Thus, it would have been obvious to one having ordinary skill in the art at the time Applicant's invention was made to select a sinusoidal seam or zig-zag seam as the seam in Guest since both seams are interweaving shapes and would therefore overcome the weakness of a butt joint, as taught by Guest, and since the specific shape would be determined by one of ordinary skill depending on the intended end appearance of the finished product, absent the showing of unexpected result.

Regarding claims 90-94, footballs and basketballs have a myriad of different surface textures. Therefore, as long as there is one football or basketball having the same texture as Guest then the limitation is taught. Because there are a number of different surfaces textures it would have been obvious to one having ordinary skill in the art at the time Applicant's invention was made to form the texture in whatever texture desired for its intended purpose including textures that overlap with the many textures forming the surface of different footballs and basketballs.

17. Claims 55-56 and 90-94 are rejected under 35 U.S.C. 103(a) as being unpatentable over Raymond et al (USPN 7,153,555).

The applied reference has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art only under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 103(a) might be overcome by: (1) a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the

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inventor of this application and is thus not an invention “by another”; (2) a showing of a date of invention for the claimed subject matter of the application which corresponds to subject matter disclosed but not claimed in the reference, prior to the effective U.S. filing date of the reference under 37 CFR 1.131; or (3) an oath or declaration under 37 CFR 1.130 stating that the application and reference are currently owned by the same party and that the inventor named in the application is the prior inventor under 35 U.S.C. 104, together with a terminal disclaimer in accordance with 37 CFR 1.321(c). This rejection might also be overcome by showing that the reference is disqualified under 35 U.S.C. 103(c) as prior art in a rejection under 35 U.S.C. 103(a). See MPEP § 706.02(l)(1) and § 706.02(l)(2).

Raymond teaches all that is claimed in claim 47 and teaches that the two side edges of the insert form a straight seam having beveled overlapped edges, but fails to teach the seam is sinusoidal or zig-zag. However, Raymond teaches that in addition to the straight seam taught in Figure 1, the side edges of the insert are formed from a large number of other interweaving shapes and mating techniques to obtain the beneficial features of the container, which is to overcome the weakness inherent in a butt joint between the side edges of the insert including a “zipper” like structure (col.9, l.40-63). Therefore, it would have been obvious to one having ordinary skill in the art that any interweaving shape seams would be used to form the seam between the side edges of the insert in order to overcome the weakness of a butt joint, as taught by Guest.

Thus, it would have been obvious to one having ordinary skill in the art at the time Applicant’s invention was made to select a sinusoidal seam or zig-zag seam as the seam in Raymond since both seams are interweaving shapes and would therefore overcome the weakness

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of a butt joint, as taught by Raymond, and since the specific shape would be determined by one of ordinary skill depending on the intended end appearance of the finished product, absent the showing of unexpected result.

Regarding claims 90-94, footballs and basketballs have a myriad of different surface textures. Therefore, as long as there is one football or basketball having the same texture as Raymond then the limitation is taught. Because there are a number of different surfaces textures it would have been obvious to one having ordinary skill in the art at the time Applicant's invention was made to form the texture in whatever texture desired for its intended purpose including textures that overlap with the many textures forming the surface of different footballs and basketballs.

18. Claims 60 and 63-64 is rejected under 35 U.S.C. 103(a) as being unpatentable over Goggins (USPN 6,490,092) in view of Guest (USPN 6,490,093).

Regarding claim 60, Goggins teaches all that is claimed in claim 57 but fails to teach the thickness of the substrate layer. However, Guest teaches that substrates of ink or plastic on the backside of a lenticular lens sleeve molded to a container has a thickness in the range of 0.5 mils to 3 mils (col.12, 1.24-27 and col.13, 1.25-30) and that the exact thickness is determined based on the intended end result of the article. Therefore, it would have been obvious to one having ordinary skill in the art at the time Applicant's invention was made that the thickness of the substrate of a lenticular lens sleeve should be determined by one of ordinary skill in the art based on the intended end result of the article and that a typical range is within 0.5 mils and 3 mils, as taught by Guest.

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Thus, it would have been obvious to one having ordinary skill in the art at the time Applicant's invention was made to select the thickness of the substrate layer of Goggins in the range between 0.5 mils and 3 mils since it is a typical range for a substrate for used for the same purpose as Goggins and since one of ordinary skill in the art would select the thickness desired based on the intended end result of the article, as taught by Guest.

Regarding claims 63-64, Goggins teaches all that is claimed in claim 57 and teaches that the two side edges of the insert form a seam (Figure 6). Goggins fails to teach that the seam is a sinusoidal or zig-zag seam. However, Guest teaches that in addition to a straight seam, interweaving shaped seams and mating techniques are used to bring the two side edges of the insert together to form the sleeve around the container, in order to overcome the weakness inherent in a typical butt joint (col.10, l.1-6). Therefore, it would have been obvious to one having ordinary skill in the art at the time Applicant's invention was made that other shaped seams are used in place of straight seam joints in order to form an interweaving connection that is inherently stronger than a typical straight seam, as taught by Guest.

Thus, it would have been obvious to one having ordinary skill in the art at the time Applicant's invention was made to form the seam of Goggins having an interweaving shape rather than a straight seam in order to form a stronger seam, and that sinusoidal or zig-zag shaped seams would be selected as interweaving shapes depending on the intended end appearance of the finished product, absent the showing of unexpected result.

Response to Arguments

19. Applicant's arguments filed August 21, 2007 have been fully considered but they are not persuasive.

In response to Applicant's argument that the references do not anticipate the claims because they comprise convex lenses formed in a side-by-side arrangement with the lenticules extending parallel to each other, the claims given the broadest reasonable interpretation do not limit the article to inserts that do not include lenticules. Specifically, the limitation "non-lenticular textured or roughened surface" limits a textured surface to be non-lenticular but does not limit a roughened surface and lenticular surfaces have the same structure as a roughened surface. Furthermore, only the first surface of the insert comprises the non-lenticular textured or roughened surface, and both Raymond and Guest teach the insert contains lenticules but the first surface of the insert comprises optical ridges that are non lenticular.

Conclusion

20. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

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CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher P. Bruenjes whose telephone number is 571-272-1489. The examiner can normally be reached on Monday thru Friday from 8:30am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Keith Hendricks can be reached on 571-272-1401. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Christopher P Bruenjes
Examiner
Art Unit 1794

CPB
October 15, 2007


ALICIA CHEVALIER
PRIMARY EXAMINER